

## REMARKS

### STATUS OF THE CLAIMS

In accordance with the foregoing, claims 1, 7, 13, 19 and 22 have been amended. Claims 1-3, 6-9, 12-15, 18, 19 and 22 are pending and under consideration.

No new matter is being presented, and approval of the amended claims is respectfully requested.

### REASONS FOR ENTRY

Applicants request entry of this Rule 116 Response and Request for Reconsideration because the claim amendments to independent claims 1, 7, 13, 19 and 22 are intended to overcome the rejections under 35 U.S.C. §112 and to further clarify the features of the present invention. The amendments should not entail any further search by the Examiner since no new features are being added or no new issues are being raised. The amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed.

### REJECTIONS UNDER 35 U.S.C. §112

On pages 2-3, items 3a and 3b, claims 1-3, 7-9, 12-15, 19 and 22 are rejected as being incomplete for omitting essential structural cooperative relationships of elements. Specifically, regarding claim 1, for example, the Examiner states that nowhere in the body of the claims is there an indication that a purchase can be made.

However, Applicants respectfully submit that independent claim 1, for example, is not directed to making a purchase. Claim 1 recites that purchase information is stored when the member utilizes the advertising information. Utilizing the advertising information does not necessarily mean that the member purchases the advertised item. For example, the advertising information can be "utilized" for a purchase simulation 181 (see, for example, Fig. 6 and paragraphs [0051]-[0052] of the present application). Therefore, to further clarify the features of the claimed invention, independent claims 1, 7, 13 and 22 are amended herein to recite that an employee utilizes the advertising information to make a purchase simulation. (See also paragraph [0038] of the present specification).

Further, the Examiner states that the term "aggregate" is indefinite, since it is unclear if Applicants are referring to the collective body of purchase information from a single transaction

(e.g., the employee number, purchase amount, quantity of purchase, etc.), or aggregate information across a group of employees.

Applicants respectfully submit that "aggregate" refers to the purchase information of a plurality of members/employees being sent in aggregate to the advertising company. In this manner, feedback may be given to the advertising company such that privacy is ensured for employees of a company, for example (see paragraph [0037] of the present specification). Thus, the value of the advertising can be increased (see also paragraph [0053] of the present specification).

Therefore, independent claims 1, 7, 13 and 22 are amended herein to recite that the purchase information of a plurality of members/employees is sent in aggregate to the advertising company.

Finally, the Examiner states that independent claim 19 recites that confirmation information is stored and sent to a second source, but does not recite generating a confirmation. Therefore, independent claim 19 is amended herein to recite a confirmation data structure that generates and stores confirmation information.

As a result, it is respectfully submitted that the rejections under 35 U.S.C. § 112 are overcome and should be withdrawn.

**REJECTIONS OF CLAIMS 1-3, 6-9, 12-15, 18, 19 AND 22 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY VALENTINO (U.S. PATENT NO. 4,648,037)**

The rejections of claims 1-3, 6-9, 12-15, 18, 19 and 22 are respectfully traversed and reconsideration is requested.

The Examiner states that Valentino discloses a purchase information file that stores purchase information when the member utilizes the advertising information, the purchase information being sent in aggregate to the advertising company, citing Valentino, column 5, lines 49-64, and column 14, lines 34-44.

As the Examiner suggests, Valentino merely discusses a purchase information file, which is a file containing the benefits and allocation amounts that an employee has elected within the benefit package. In the Response to Arguments, on pages 11-12, the Examiner states that this file is inherently sent to the company who operates the investment vehicles, which the employee elects to purchase.

However, as stated above, the term "aggregate" refers to the purchase information of a plurality of members/employees being sent in aggregate to the advertising company. In this manner, feedback may be given to the advertising company such that privacy is ensured for

employees of the company, for example.

It is respectfully submitted that Valentino fails to teach or suggest sending the purchase information in aggregate, as recited in independent claim 1. Therefore, it is respectfully submitted that independent claim 1, as amended, patentably distinguishes over the prior art.

Amended independent claims 7, 13 and 22 recite similar features to amended independent claim 1, discussed above, and thus it is respectfully submitted that independent claims 1, 7, 13 and 22 patentably distinguish over the prior art, for at least the reasons provided above.

Dependent claims 2, 3, 6, 8, 9, 12, 14, 15 and 18 inherit the patentability of their respective base claims and, thus, it is further submitted that the pending dependent claims also patentably distinguish over the prior art.

Regarding independent claim 19, the Examiner states that Valentino reads on a confirmation data structure that stores confirmation information, to be sent to a second source. Specifically, in the Response to Arguments, on page 12 of the Action, the Examiner states that Valentino discloses printing a confirmation. Thus, a confirmation is sent to the printer, which constitutes a second source.

Independent claim 19, as amended herein, recites that the confirmation information is to be sent to a source of advertisement information. Valentino fails to teach or suggest sending confirmation information to a source of advertisement information.

In fact, column 5, lines 59-64, of Valentino, states that a printer 23 can be included in the benefit and financial communication system so that only the employee can obtain a written record of the displayed information. Column 14, lines 42-44, states that written confirmation can be produced when various transactions are carried out; however, Valentino makes no mention of storing confirmation information, *to be sent to a source of advertisement information*, as recited in amended independent claim 19. Therefore, it is respectfully submitted that independent claim 19 patentably distinguishes over the prior art.

Applicants note that dependent claims 3, 9 and 15 recite a feature similar to that discussed above for independent claim 19. Thus, it is further submitted that dependent claims 3, 9 and 15 further patentably distinguish over the prior art for the reasons set forth above.

## CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art. There being no further outstanding objections or

Serial No. 09/919,844

rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: November 30, 2006

By: Michael P. Stanley  
Michael P. Stanley  
Registration No. 58,523

1201 New York Avenue, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501